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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|-----------------------|------------------|
| 09/784,865 | 02/15/2001 | Jennie Ching | 1914P/STL920000089US1 | 4574 |

7590 06/17/2008
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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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2162

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| MAIL DATE | DELIVERY MODE |
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06/17/2008

PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* JENNIE CHING and ERIC HSIAO
9

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11 Appeal 2007-3732
12 Application 09/784,865¹
13 Technology Center 2100
14

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16 Decided: June 17, 2008
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20 Before JAMES D. THOMAS, JAY P. LUCAS, and
21 CAROLYN D. THOMAS, *Administrative Patent Judges*.

22
23 THOMAS, C., *Administrative Patent Judge*.
24

25 DECISION ON APPEAL
26

27 I. STATEMENT OF THE CASE

28 Appellants appeal under 35 U.S.C. § 134 from a final rejection
29 of claims 1-15 mailed January 26, 2005. We have jurisdiction under
30 35 U.S.C. § 6(b).

31 We affirm.
32

¹ Application filed February 15, 2001. The real party in interest is International Business Machines Corp. (IBM).

A. INVENTION

Appellants invented a system, method, and a computer readable medium for synchronizing files between a central site and a plurality of remote sites. (Spec., 3.)

B. ILLUSTRATIVE CLAIMS

The appeal contains claims 1-15². Claims 1, 7 and 10 are independent claims. Claims 1 and 7 are illustrative:

1. A method of synchronizing files between a central site and a plurality of remote sites comprising the steps of:
 - (a) providing a list of files to the plurality of remote sites by the central site, prior to a callback time of the remote sites;
 - (b) reporting which of the files are missing by each of the plurality of remote sites to the central site; and
 - (c) determining within the central site which of the files needs to be sent to each of the plurality of remote sites.

7. A system for synchronizing files comprising:
 - a central site, the central site including a file system synchronization (FSS) helper application and an automated central site operations (ACSO) mechanism for transmitting a list of files; and
 - at least one remote site, the at least one remote site including a file system synchronization remote operating mechanism (FSS RSO), wherein the FSS RSO mechanism creates a group of files it will need based upon the transmitted list of files.

² The dependency of claim 14 shall be treated as dependent upon claim 10 for appeal purposes.

C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

| | | |
|--------|-----------------|---------------------------------------|
| Bell | US 5,758,150 | May 26, 1998 |
| Gayman | US 6,256,673 B1 | Jul. 3, 2001 (Filed Dec. 17, 1998) |

D. REJECTION

The Examiner entered the following rejection which is before us for review:

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bell in view of Gayman.

II. PROSECUTION HISTORY

Appellants appealed from the Final Rejection and filed a substitute Appeal Brief (App. Br.) on September 6, 2006. The Examiner mailed an Examiner's Answer (Ans.) on January 3, 2007. Appellants filed a Reply Brief (Reply Br.) on October 10, 2006.

III. ISSUE

Whether Appellants have shown that the Examiner erred in rejecting the claims as being obvious over the combination of Bell and Gayman.

IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Claim Construction

1
2 1. The Specification discloses that “[e]ach of the remote sites 14 are
3 configured to report back to the central site 10 at a pre-defined time, based
4 on a callback scheduling algorithm.” (Spec., 10:9-10).

5
6 *Bell*

7 2. Bell discloses a system and method for database synchronization
8 wherein the data and information in a database of change are converted into
9 series of flat files that are transferred from each remote computer to the
10 central computer. (Abstract.)

11 3. In Bell, the database of change is a record of all the updates,
12 additions, or deletions made to the databases on the data storage devices.
13 (Col. 4, ll. 21-25.)
14

15 *Gayman*

16 4. Gayman discloses a client/server network system for cyclic
17 multicasting of an image file from a central data provider to one or more
18 client machines. (Abstract.)

19 5. Gayman discloses that an image file “consists of a single file
20 containing the contents of an entire disk or an entire hard drive.” (Col. 3, ll.
21 15-19.)

22 6. Gayman discloses that:

23 [i]f the client machine has not requested for an image file . . . ,
24 the central data provider (server) **410** determines whether the image
25 file is in a transmission queue for a current cycle at step **514**. . . . if the
26 image file is in the transmission queue for the current cycle at step
27 **516**, the central data provider (server) **410** continues transmission of
28 the image file for the current cycle . . .

(Col. 8, ll. 19-28; Fig. 5)

V. PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

VI. ANALYSIS

Grouping of Claims 1-15

In the Brief, Appellants argue claims 1-6 and 10-15 as a group (App. Br. 4-10). Thus, the Board selects representative claim 1 to decide the appeal for this group. Accordingly, the remaining claims in this group stand or fall with claim 1.

Appellants argue claims 7-9 as a group (App. Br. 10-11). The Board selects representative claim 7 to decide the appeal for this group. Accordingly, the remaining claims in this group stand or fall with claim 7.

See 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

The Board's Claim Construction

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

Claims are given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

From our review of the Specification, we note that Appellants have identified a "callback time" as a pre-defined time that the remote sites report back to the central site (FF 1). Therefore, we find that a "callback time" includes any time when a communication is received from the remote site to the central site.

The Obviousness Rejection

We now consider the Examiner's rejection of claims 1-15 under 35 U.S.C. § 103(a) as being obvious over the combination of Bell and Gayman.

Claims 1-6 and 10-15

Appellants contend that "Bell fails to teach or suggest '(b) reporting which of the files are missing by each of the plurality of remote sites to the central site; and (c) determining within the central site which of the files needs to be sent to each of the plurality of remote sites,' as recited in claims 1 and 10." (App. Br. 6; Reply Br. 4.) We agree-in-part.

While we find that Bell discloses transferring data, e.g., a series of flat files, from each remote computer to a central computer (FF 2), we do not readily find and the Examiner has not adequately shown where Bell discloses sending information from the central site to the remote sites. In Bell, it is the remote computer that creates a "database of change" that includes a record of all changes in the data, including deletions (i.e., missing files) (FF 3), and transmits this information to the central site as flat files (FF 2). Thus, we find that Bell reports to the central site which files are missing/deleted by each of the plurality of remote sites, but does not show the central site determining which files needs to be sent. However, Gayman (as discussed below) discloses a central site determining which files needs to be sent.

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). Our reviewing court has repeatedly warned against confining the claims to specific embodiments

1 described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323
2 (Fed. Cir. 2005) (en banc). During prosecution before the USPTO, claims
3 are to be given their broadest reasonable interpretation, and the scope of a
4 claim cannot be narrowed by reading disclosed limitations into the claim.
5 See *In re Morris*, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997); *In re Zletz*, 893
6 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05
7 (CCPA 1969). “An essential purpose of patent examination is to fashion
8 claims that are precise, clear, correct, and unambiguous. Only in this way
9 can uncertainties of claim scope be removed, as much as possible, during the
10 administrative process.” *In re Zletz*, 893 F.2d at 322.

11 What is significant here is that the step of “*providing a list of files*”
12 does not positively recite any relationship to the remaining steps of
13 “*reporting which of the files are missing by each of the plurality of remote*
14 *sites*” and “*determining within the central site which of the files needs to be*
15 *sent*” recited in claim 1. All that is recited is *which of the files are missing*
16 and *which of the files needs to be sent*. We find that the recited “files” can
17 include any files on the respective devices, not merely the files provided on
18 the list. Thus, we find a disconnect between the *providing a list of files* and
19 the additional features recited in claim 1. As such, we find that claim 1 does
20 not require that the “report of which files are missing” be files specifically
21 from the provided list. As noted above, Bell discloses reporting files
22 missing/deleted from the remote sites.

23 Gayman discloses transmitting information from a central device to
24 one or more client machines (FF 4). Thus, we find that the claimed
25 *determining within the central site* step reads on Gayman’s transmitting of
26 information from the central device to the client machine. Here again, we

1 find that the claimed *determining step* does not positively recite any
2 relationship to the *reporting step*. Hence, the determination is not reliant
3 upon the report from the remote sites. Thus, there is again a disconnect
4 between features in claim 1. All that Gayman is required to show is a
5 central site determining which files needs to be sent to the remote sites. The
6 act itself of sending files reads on determining a need.

7 Regarding Gayman, Appellants “fail[] to see how a single file
8 containing the entire contents of a disk or hard drive teaches or suggests a
9 list of files.” (App. Br. 9; Reply Br. 4.) We disagree.

10 Gayman discloses transmitting an image file which contains the
11 content of an entire hard drive (FF 4-5). We find that the content of the
12 entire hard drive would inherently include “a list of all files and directories”
13 on the hard drive, among other things. The fact that Gayman may also
14 transmit the files themselves does not negate that a listing of the files would
15 also be inherently included.

16 Appellants “fail[] to see how this [Bell and Gayman] teaches or
17 suggests providing a list of files to the plurality of remote sites by the central
18 site prior to a callback time of the remote sites.” (App. Br. 10.) We
19 disagree.

20 Gayman discloses that if the client machine has not requested an
21 image, i.e., has not made a callback/request, the central site may make a
22 determination to transmit an image file (FF 6). Thus, we find that Gayman
23 discloses providing an image file, e.g., a list, to the remote sites prior to a
24 request (i.e., a callback time) of the remote sites.

25 Therefore, we do not find that Appellants have shown that the
26 combination of Bell and Gayman lacks the above-noted disputed features of

1 claim 1. Therefore, we affirm the rejection of independent claim 1 and of
2 claims 2-6 and 10-15, which fall therewith.

3
4 *Claims 7-9*

5 Appellants “fail[] to see how Bell teaches or suggests the recited
6 central site that includes a mechanism for transmitting the list of files, as the
7 Examiner has admitted that that [sic] Bell does not disclose providing a list
8 of files by a central site prior to a callback time of the remote sites.” (App.
9 Br. 10.) We agree. However, as noted *supra* Gayman is being relied upon
10 to disclose such features. Thus, we find that the combination of Bell and
11 Gayman discloses the aforementioned disputed features.

12 Therefore, we do not find that Appellants have shown error in the
13 Examiner’s rejection of illustrative claim 7. Instead, we find the Examiner
14 has set forth a sufficient initial showing of obviousness.

15 Therefore, we affirm the rejection of independent claim 7 and of
16 claims 8 and 9, which fall therewith.

17
18 *No combinability arguments*

19 We note that Appellants have presented no arguments directed to the
20 combinability of the references Bell and Gayman. Accordingly, Appellants
21 have waived any such arguments, and the combinability of such references
22 will not be addressed here.

23
24 VII. CONCLUSIONS

25 We conclude that Appellants have *not* shown that the Examiner erred
26 in rejecting claims 1-15.

VIII. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-15.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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